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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/787,875 | 07/19/2001 | Jens Ehlers | 1998/G-021 | 8024 |
| 23416 | 7590 | 06/06/2005 | EXAMINER | |
| CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899 | | | RABAGO, ROBERTO | |
| | | | ART UNIT | PAPER NUMBER |

1713

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,875

Applicant(s)

EHLERS ET AL.

Examiner

Roberto Rábago

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/1/2005 has been entered.

2. Prior rejection over Heinrich et al. (US 5,292,837) is withdrawn in view of the narrowed scope of bulk density in claim 1.

Claim Rejections - 35 USC § 102

3. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Spencer et al. (US 5,633,419) for the reasons set forth in item 3 of the Office action mailed 3/22/2004 and remarks in the Office action mailed 10/28/2004.

4. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Marchand et al. (US 4,910,272) for the reasons set forth in item 4 of the Office action mailed 3/22/2004 and remarks in the Office action mailed 10/28/2004.

5. Applicant's arguments filed 4/1/2005 have been fully considered but they are not persuasive. Regarding the new limitation "consisting essentially of" the following passages from MPEP 2111.03 are noted:

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original).

For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355.

Applicants' specification includes a statement that an object of the invention is a process for making polymer with an irregular particle structure (pg. 3, lines 1-3), and therefore this appears to be a feature which applicants consider to be basic and novel. However, the specification is silent on the type or degree of irregularity intended (i.e., particle size, particle shape, etc.), and the cited references include this feature within the broad scope implied in applicants' specification. Spencer '419 includes electron micrographs of particles which are clearly irregular. Marchand '272 has used conventional silica which is not described as being spherical or having been screened for size; accordingly, this silica would be irregular in both size and shape.

Applicants' traversal is based on the mere presence of silica and magnesium components present in the reference methods, and state that these components are

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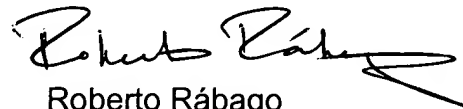
excluded from the claims by the phrase "consisting essentially of". However, the specification appears to be devoid of any statement which would indicate or imply that the basic and novel characteristics of the invention correspond to using a catalyst which lacks additional components such as a support or magnesium component. Applicants clearly envision additional reaction components which will have a dramatic effect on the resultant polymer (e.g., a molar mass regulator such as hydrogen, see spec. at pg. 3, lines 4-9, and examples 1-4), but the specification is silent on whether or not other components are to be included or excluded from the process. Therefore, at least with respect to the presence of a support and a magnesium component, "consisting essentially of" must be construed as equivalent to "comprising" regarding the presence of additional components not recited in the claims.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Roberto Rábago', with a stylized flourish at the end.

Roberto Rábago
Primary Examiner
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RR
May 27, 2005